

U.S. Pat. Appln. Serial No. 10/612,216
Response to Office Action dated April 7, 2005
Page 4 of 6

REMARKS

1. Status

Claims 1-10 are pending in the application. Claims 1-10 are rejected. Applicants have amended claims 1-10 to overcome the rejection and to place the application in condition for allowance.

2. Rejection Under 35 U.S.C. § 102

In the Office Action dated April 7, 2005, the Examiner rejected Claims 1, 3, 7-10 under 35 U.S.C. § 102(b) as being anticipated by Costello et al. (U.S. Pat. No. 5,322,507). Specifically, the Examiner stated that Costello et al. disclose a non-implantable device for the treatment of prostate, the device comprising: a light source that provides a therapeutic light suitable for the required treatment (col. 1, lines 16-25); and a light source segment 68 that houses a laser light transmitting fiber 70, said light source segment being of sufficiently small size and configuration to be inserted through the urethra of a patient (col. 3, lines 53-56).

With regard to the previous amendment reciting a limitation of "light source emitting light which is absorbed by blood," the Examiner stated that IR light generated by YAG lasers is within the absorption spectra of water and, therefore, water in the blood inherently absorbs the output radiation of the laser.

Applicants note that a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single, allegedly, anticipating reference. Blood contains plasma (approximately 90 percent water) in which corpuscular elements such as erythrocytes (red blood cells), leukocytes (white blood cells) and thrombocytes (platelets) are present. Various other compounds, including proteins, electrolytes, carbohydrates, minerals, and fats are dissolved in it. Applicants suggest that the missing characteristic argued by the Examiner, i.e. that IR light generated by YAG laser is within the absorption spectra of water and, therefore, water in the blood must necessarily absorb the emitted light is incorrect. With so many additional other components in the blood, i.e. both formed elements and dissolved elements, it is inconceivable to think that only the water

U.S. Pat. Appln. Serial No. 10/612,216
Response to Office Action dated April 7, 2005
Page 5 of 6

component absorbs the emitted light. Nevertheless, Applicants have amended the claims to recite that the light is absorbed by the red blood cells in the blood. A formed element, i.e. an erythrocyte, is not within the same absorption spectra as water and therefore is not necessarily present, or inherent, in Costello nor anticipated by Costello. This amendment is fully supported in the specification in paragraph 45 spanning pages 13 and 14. It is believed that with the amendment to the claims, the claims are now allowable.

3. Rejection under 35 U.S.C. §103.

The Examiner rejected claims 2 and 4-6 under §103 as being unpatentable over Costello in view of Tulip (U.S. Pat. No. 5,059,200) and Ganz (U.S. Pat. No. 6,491,618), stating that Tulip teaches an alternative, non-implantable, laser lithotripter for treating urological disorders, the lithotripter comprising a pulsed light source having a pulse-width and wavelength as recited in the instant claims (col. 7, line 4-35). Because the claims depend from claims which distinguish over the art of record, so too do the dependent claims distinguish over the art of record.

Conclusion

Applicants have made a novel and non-obvious contribution to the art of treating urological disorders with its apparatus. Applicants respectfully submit that with the arguments and amendments presented herein all pending claims are allowable over the art of record, for at least the reasons discussed above, and respectfully requests that a Notice of Allowance be issued in this case.

U.S. Pat. Appln. Serial No. 10/612,216
Response to Office Action dated April 7, 2005
Page 6 of 6

If the Examiner believes that a teleconference would be of value in expediting the allowance of the pending claims, the undersigned can be reached at the telephone number listed below. This response has been filed within the three-month statutory time for response and it is, therefore, believed that no petition or payment for extension of fees is due. If, however, it is believed that any additional fees are necessary, the Commissioner is hereby authorized to charge or credit any such fees or overpayment to Deposit Account No. 50-1901 (Reference No. 687-411/US/3).

Dated: June 7, 2005

Respectfully submitted,

OPPENHEIMER, WOLFF & DONNELLY LLP
Attorneys for Applicant

By



Barbara A. Wrigley
Reg. No. 34,950
45 South 7th Street, Suite 3300
Minneapolis, MN 55402
Telephone No. (612) 607-7595
Facsimile No. (612) 607-7100
E-Mail Bwrigley@Oppenheimer.com

Customer No. 34205